

REMARKS

Claims 1-46 are pending in the application. Applicants respectfully request reconsideration of the rejections set forth in the Office Action dated August 9, 2005 in light of the following remarks.

In the Specification

The first paragraph has been updated to add a patent application number and patent number for two related documents previously identified but whose serial numbers were not known at the time of filing this patent application. No new matter has been added.

Rejections Under 35 U.S.C. §103

Claims 1, 3-4, 7-11, 13, 14, 16-17, 19-20, 22-25, 27-28, 31-34, 36-37, 39-40, 42-43 and 46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,907,374 ("Liu") in view of U.S. Patent No. 6,412,112 ("Barrett").

Liu describes a system that can flexibly re-encode video data at different compression levels. He notes that conventional video processors are too complicated (col. 2, lines 53-59) and derives a simplified system.

Barrett provides a server for use with WebTV that provides multiple services (broadcast video, email, web access, etc.) and overcomes issues associated with transmission over POTS lines.

The Office Action notes that Liu does not describe "a reduced bit rate for the video bitstream that meets a bandwidth constraint, wherein the video bitstream before filtering does not meet the bandwidth constraint and the video bitstream including the modified transform coefficients includes the reduced bit rate that meets the bandwidth constraint". The Office Action relies on combination with Barrett to teach this omission.

Applicants respectfully traverse the rejection. The combination a) uses references with divergent intent, b) contradicts rules for the combination of references per the MPEP, and c) still fails to teach all limitations recited in the claims.

First, the references invent for contrary goals. Liu unmistakably wants to reduce resources for processing bitstreams (see col. 1, lines 8-10 and col. 2, lines 16-22); Barrett tailors complicated servers to overcome video transmission over POTS lines (see col. 1, line 17 to col. 2, line 17). Thus, one reference wants to simplify hardware, while the other develops sophisticated and dedicated hardware targeted for a specific need. The opposing approaches permeate their teachings. For example, to avoid real time processing, Barrett relies on changing the video format and broadcasting the video at night when no other video is being transmitted (see col. 2, lines 20-32). Oppositely, Liu focuses on simplification and real time processing (see col. 1, line 66). As states in the MPEP, **"References Cannot be Combined Where the Reference Teaches Away from Their Combination"** (MPEP 2145 X.D.2).

One of skill in the art would NOT look to Barrett (a dedicated distribution system) to modify Liu (a simplified transcoder). Liu openly wants to "reduce resources required to perform processing of bitstreams" (see col. 1, lines 6-9). Barrett's webTV terminal distribution system certainly adds resources: a) the "server offers supplemental services such as email, news reports, television guides and enhanced access to web pages" (see col. 2, lines 1-5); b) software on the client terminal converts data to an intermediate format (to be unconverted downstream); c) the servers transmit at restricted times; d) the system adds codebooks and codebook processing to both encoders and decoders (see col. 2, lines 8-21), etc. **"The proposed modification cannot render the prior art unsatisfactory for its intended purpose"** (MPEP 2143.01). Modifying Liu with Barrett's complicated servers destroys the intent of reduced resources by Liu. The combination of these two references is thus improper.

In addition, Liu teaches against the claimed invention. Liu mainly uses downsampling or re-quantization with a different step size to control bit rate. Where filtering is briefly mentioned, it is mentioned as an assist to processing or to reduce buffering. Liu generally teaches against filtering since it results in poorer video quality (col. 18, lines 19-51). Filtering to the extent of reaching bandwidth constraints is not taught by Liu, but would only lead to worse video quality according to the teachings of Liu. **"Prior Art Must Be Considered in Its Entirety, Including Disclosures That Teach Away From the Claims"** (MPEP 2141.02).

Moreover, despite the dubious combination, the references still fail to teach all limitations of the claims. As mentioned above, the Office Action notes that Liu does not describe "a reduced bit rate for the video bitstream that meets a bandwidth constraint, wherein the video bitstream before filtering does not meet the bandwidth constraint and the video bitstream including the

modified transform coefficients includes the reduced bit rate that meets the bandwidth constraint", and relies on Barrett to teach this limitation (see page 3, pars. 5-6). But Barrett also fails in this regard. Barrett only describes that the transmission size of digitally compressed video data varies with the data. He does not even mention a bandwidth constraint, filtering, or filtering to meet a bandwidth constraint. Barrett does not teach or remotely suggest "a reduced bit rate for the video bitstream that meets a bandwidth constraint, wherein the video bitstream before filtering does not meet the bandwidth constraint and the video bitstream including the modified transform coefficients includes the reduced bit rate that meets the bandwidth constraint" as recited. Thus, both references still fail to teach all limitations of the claims.

For at least these reasons, Applicants respectfully submit that Liu and Barrett, either alone or in combination, do not teach or suggest independent claims 1, 8, 22, 31 and 40 and that the independent claims are allowable.

Claims 2, 5, 15, 18, 26, 29, 38, 41, and 44 were rejected under 35 U.S.C. § 103(a) as being anticipated by U.S. Patent No. 5,907,374 ("Liu") in view of U.S. Patent No. 6,002,801 ("Strongin").

Claims 12 and 35 were rejected under 35 U.S.C. § 103(a) as being anticipated by U.S. Patent No. 5,907,374 ("Liu") in view of U.S. Patent No. 6,661,923 ("Koike").

At the least, Strongin and Koike do not remedy deficiencies of the primary references in rejecting the independent claims. Dependent claims 2-7, 9-21, 23-30, 32-39 and 41-46 each depend directly or indirectly from independent claims 1, 8, 22, 31 and 40, respectively, and are therefore respectfully submitted to be patentable over the art of record for at least the reasons set forth above with respect to the independent claims. Further, the dependent claims recite additional elements which when taken in the context of the claimed invention further patentably distinguish the art of record.


Withdrawal of the rejections under 35 USC §103(a) are therefore respectfully requested.

Applicants believe that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Applicants hereby petition for an extension of time which may be required to maintain the pendency of this case, and any required fee for such extension or any further fee required in connection with the filing of this Response is to be charged to Deposit Account No. 50-0388 (Order No. CISC219).

Respectfully submitted,

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